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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/553,524	04/20/2000	Charles Eric Hunter	IVOO-0138	5419

23377 7590 04/04/2007  
WOODCOCK WASHBURN LLP  
CIRA CENTRE, 12TH FLOOR  
2929 ARCH STREET  
PHILADELPHIA, PA 19104-2891

EXAMINER
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KOENIG, ANDREW Y

ART UNIT	PAPER NUMBER
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2623

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/04/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

09/553,524

Applicant(s)

HUNTER ET AL.

Examiner

Andrew Y. Koenig

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 30-33,36-39,41-45,47-50,57,60-64,114-118 and 121-145 is/are pending in the application.
- 4a) Of the above claim(s) 30-33,36-39,41-45,47-50,114-118 and 121-145 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 57 and 60-64 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Newly submitted claims 30-33, 36-39, 41-45, 47-50, 114-118, and 121-145 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Independent claims 30 and 121 are directed to a storing content in a proprietary encoded format that prevents display of the content which are distinct from selecting content based upon popularity and storing and retrieving content from a separate storage device as previously recited.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 30-33, 36-39, 41-45, 47-50, 114-118, and 121-145 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 57, 60-64 have been considered but are moot in view of the new ground(s) of rejection.

The applicant argues that the prior art (Russo and Salganicoff) fail to teach or suggest "automatically selecting desired digital data content from the blanket transmitted digital data content according to predetermined criteria based on the popularity of the digital data content." The examiner disagrees; Russo teaches automatically selecting desired digital data content from the blanket transmitted digital

Art Unit: 2623

data content according to predetermined criteria (Abstract, col. 6, ll. 9-12, col. 7, ll. 29-34, col. 9-10, ll. 38-10), such as a first-run movie and viewer preferences, but is merely silent on based upon popularity. Salganicoff teaches a basing an agreement matrix (a matrix of available programming and the user profile) using weighting such as national popularity (col. 48, ll. 27-35), which is designed to provide the most relevant programming to the user at a given time. One of ordinary skill in the art would readily recognize using popularity as taught by Salganicoff for the benefit of weighting the popular programming so as to provide content that is the most desirable to the customer during a time frame (Salganicoff: col. 4, ll. 60-64).

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 57 and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,619,247 to Russo in view of U.S. Patent 5,734,720 to Salganicoff.

Regarding claim 57, Russo teaches blanket transmitting movies and music selections to customers via a cable television input or a satellite (col. 6, ll. 9-12, col. 7, ll. 29-34), and automatically recording a movie at a first user station of a first viewer, (Abstract, col. 9-10, ll. 38-10), which reads on at a first user station of a first viewer,

Art Unit: 2623

automatically selecting desired digital data content from the blanket transmitted digital data content according to predetermined criteria.

Russo teaches playing back the selected movie, (figure 1; col. 3-4, ll. 65-2).

Russo teaches communicating the movie selection to a program provider (col. 6, ll. 9-12), wherein the program provider of also bills the customers for the recorded selections and movies that actually played (col. 5, ll. 1-10), wherein the program provider is a location remote from the viewer, which reads on receiving information from the first user station at a remote location indicating that a selected digital data content item has been displayed.

Russo teaches selecting using viewer preference information, but Russo is silent on a criteria based on popularity.

Salganicoff teaches using national popularity as a criterion in suggesting programming to a user (col. 48, ll. 27-45). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Russo by selecting based on popularity as taught by Salganicoff in order to provide popular content to the user thereby providing content that is the most desirable to the customer during a time frame (Salganicoff: col. 4, ll. 60-64).

Regarding claim 60, Russo is teaches on transmitting classification information, comparing the classification information, and automatically selecting the programs to be stored (col. 3, ll. 12-16). However, Russo is silent on the classification information being in the header. Official Notice is taken that indirect classification information being in the

header is well known such as using classification identifying PIDs of an MPEG stream, wherein the PIDs by definition of MPEG is located in the header. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Russo by identifying classification information being in the headers in order to efficiently determine whether the content would be desirable to the user.

5. Claims 61-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,619,247 to Russo and U.S. Patent 5,734,720 to Salganicoff in view of WO 92/22983 to Browne et al. (Browne).

Regarding claims 61 and 62, Russo is silent on overwriting the oldest stored data. Browne teaches deleting the oldest stored data (pg. 7-8, ll. 20-5). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Russo by deleting the oldest stored data as taught by White in order to remove content least desirable to the user.

Regarding claims 61 and 63, Russo is silent on overwriting the older released data. Browne teaches deleting the oldest stored data (pg. 7-8, ll. 20-5), which equates to "older released data" in that the data is the oldest data transmitted (e.g. released) from the transmitter. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Russo by deleting the older released data as taught by White in order to remove content least desirable to the user.

6. Claims 61 and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,619,247 to Russo and U.S. Patent 5,734,720 to Salganicoff in view of U.S. Patent Application Publication 2002/0056112 to Dureau et al.

Regarding claims 61 and 64, Russo is silent on overwriting the least fit preferences of the customer. Dureau teaches deleting the least fit preferences to make room for more programming (pg. 6, para. 0051). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Russo by deleting the least fit preferences as taught by Dureau in order to remove content least desirable to the user thereby creating space for new programming.

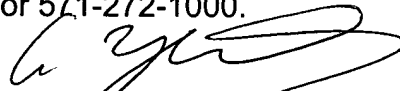
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Y. Koenig whose telephone number is (571) 272-7296. The examiner can normally be reached on M-Fr (8:30 - 5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571)272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2623

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Andrew Y Koenig  
Primary Examiner  
Art Unit 2623

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